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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,001	06/21/2001	Shawn Ray Isaacson	IOME-0421/P0736	8516

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EXAMINER
HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
2131	5

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DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/888,001	ISAACSON ET AL.	
	Examiner	Art Unit	
	Matthew T Henning	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 June 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This action is in response to the communication filed on 06/21/2001.

DETAILED ACTION

1. Claims 1-19 have been examined.

Title

2. The title of the invention is acceptable.

Priority

3. No claim for priority has been made for this application.

4. The effective filing date for the subject matter defined in the pending claims in this application is 06/21/2001.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 09/07/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Drawings

6. The drawings filed on 06/21/2001 are acceptable for examination proceedings.

Specification

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The abstract of the disclosure is objected to because

Line 7: The phrase "are provided" can be implied and therefore must be removed.

Lines 13-14 recite "This technique...Total Recorder product" refers to purported merits or speculative applications of the invention and therefore must be removed.

Correction is required. See MPEP § 608.01(b).

Claim Objections

9. The applicant is reminded that a series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Claim 16 is objected to due to a grammatical error. Lines 1 and 2 recite "is downloaded computing device" which is grammatically incorrect and therefore must be corrected.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3, 5-6, 8-11, and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukamoto et al. (US Patent Number 5,796,828), hereinafter referred to as Tsukamoto.

12. Claim 1 recites a computing device comprising storage (See Tsukamoto Fig. 2 Element 104A) and a processor (See Tsukamoto Fig. 2 Element 102A), wherein said processor records into said storage digital data received from one of an analog and digital source (See Tsukamoto Fig. 2 Element 103) (See Tsukamoto Col. 3 Paragraph 2), and said processor applies DRM rights to said digital data (See Tsukamoto Col. 3 Paragraph 2) and said processor enforces the DRM rights whereby the digital data may be played back only from said storage according to said DRM rights (See Tsukamoto Col. 3 Paragraph 3 wherein it was implied that the video must be played back from the previously stored data since it was not stored anywhere else).

13. Claim 2 recites that the storage comprises one of a magnetic, optical, and magneto-optical medium (See Tsukamoto Col. 3 Lines 4-10).

14. Claim 3 recites that the storage includes a removable storage medium, and said digital data may be played back only from said removable storage medium (See Tsukamoto Col. 3 Lines 1-7, Paragraph 3 wherein it was implied that the video must be played back from the previously stored data since it was not stored anywhere else, and Col. 5 Paragraph 4 Lines 1-4).

15. Claim 5 recites that the digital data includes data representing audio (See Tsukamoto Col. 1 Lines (See Tsukamoto Col. 2 Paragraph 6 wherein the source of data is a television broadcasting system, which implies that not only video data is received, but audio data is received as well).

16. Claim 6 recites that the digital data includes data representing video (See Tsukamoto Col. 2 Paragraph 6).

17. Claim 8 recites that the processor converts the digital data to a secure format, assigns a default set of DRM rights to the securely formatted data and stores the digital data after such converting and assigning (See Tsukamoto Fig. 6 Steps S63, S65, S69, and S71, and Col. 4 Paragraph 2).

18. Claim 9 recites that the processor receives a request for a new set of DRM rights, different from an initially applied set of DRM rights and alters the set of DRM rights in accordance with the requesting if at least one condition is met (See Tsukamoto Col. 16 Paragraph 4).

19. Claim 10 recites that the at least one condition includes one of a promise to pay and a payment for the new set of DRM rights requested (See Tsukamoto Col. 16 Paragraph 4 Line 6).

20. Claim 11 recites that the assigning includes assigning a default set of rights dependent upon the type of content that the digital data represents (See Tsukamoto Col. 13 Paragraph 8-Col. 15 Paragraph 1 wherein the REPRO signal stored depends on whether the data is purchased or rented content).

21. Claim 13 recites that a user requests via a user interface an action to be performed on said stored digital data and said processor compares said requested action against the set of DRM rights assigned to the digital data (See Tsukamoto Fig. 7A and Fig. 7B and Col. 15 Paragraph 2 – Col. 16 Paragraph 5).

22. Claim 14 recites that the processor denies said request if said requested action is not allowed according to set of DRM rights (See Tsukamoto Fig. 7A and 7B Steps S90 and S92).

23. Claim 15 recites that the processor grants said request if said requested action is allowed according to set of DRM rights (See Tsukamoto Fig. 7A and 7B Step S97).

24. Claim 16 recites that the digital data is downloaded computing device from a network (See Tsukamoto Col. 2 Paragraphs 7-8).

25. Claim 17 recites that the digital data is downloaded to the computing device from at least one of a wired and wireless network transmission means (See Tsukamoto Col. 2 Paragraphs 7-8).

26. Claim 18 recites that the digital data is downloaded to the computing device from at least one of a LAN, WAN, Home Network and the Internet (See Tsukamoto Col. 2 Paragraphs 7-8).

27. Claim 19 recites a server computing device for receiving requests for DRM rights via a network, whereby a user requests an alteration of DRM rights associated with digital data in storage of a computing device as recited in claim 1 in exchange for an obligation from the user, and said server computing device sends data representative of the requested DRM rights to the computing device (See Tsukamoto Fig. 7A and Fig. 7B Steps S93, S89, and S95, and Col. 6 Paragraphs 2 and 4-5 and Col. 7 Paragraph 1).

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

29. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto as applied to claim 1 above, and further in view of Naim (US Patent Number 6,694,200).

Tsukamoto disclosed storing digital data on a storage device for protected playback (See rejection of claim 1 above), but failed to disclose that the storage device could be a hard drive. However, Tsukamoto did disclose that the storage device was removable from the system (See rejection of claim 3 above).

Naim teaches that modern digital libraries require far more space than the portable storage mediums hold (See Naim Background of the invention). Naim further teaches a portable hard disk for storing digital media in order to hold more data than previously possible (See Naim Col. 2 Paragraphs 4-5).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the portable hard disk as the storage medium of Tsukamoto. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide as much data storage as possible in the removable storage device in order to hold more videos.

30. Claims 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto as applied to claim 1 above, and further in view of Duncombe (US Patent Number 6,430,582).

Tsukamoto disclosed encrypting broadcast data and then storing it (See rejection of claim 1 above) but failed to disclose the broadcast data being in the WAV format.

Duncombe teaches a media comes in many different digital forms, such as text (.txt), audio (CD, MP3, .wav), animation (flash), images (.jpeg), and video (MPEG, .avi) that can be downloaded to create different user experiences (See Duncombe Col. 4 Paragraph 3 and Col. 9 Paragraph 6 – Col. 10 Paragraph 1).

It would have been obvious to the ordinary person skilled in the art to employ the teachings of Duncombe to the controlled content distribution system of Tsukamoto by allowing content other than video to be provided to the user. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide different user experiences while protecting the rights of the owners of the distributed content.

Furthermore, because CD audio, which is stored digitally, often contains vocals which are originally captured as an analog signal, it would have been necessary that the analog vocal signals were converted to a digital signal for them to have been stored as CD audio.

Conclusion

31. Claims 1-19 have been rejected.

32. Please direct all inquiries concerning this communication to Matthew Henning whose telephone number is (703) 305-0713 until October 21st and (571) 272-3790 thereafter. The examiner can normally be reached Monday-Friday from 9am to 4pm, EST.

If attempts to reach examiner by telephone are unsuccessful, the examiner's acting supervisor, Ayaz Sheikh, can be reached at (703) 305-9648 until October 21st and (571) 272-3795 thereafter. The fax phone number for this group is (703) 305-3718.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Matthew Henning
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